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Atsushi Kato

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ROBERT J. DEPKE
LEWIS T. STEADMAN
ROCKEY, DEPKE & LYONS, LLC
SUITE 5450 SEARS TOWER
CHICAGO, IL 60606-6306

EXAMINER

BERNATZ, KEVIN M

ART UNIT

PAPER NUMBER

1794

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 1 and 11 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (JP 2002-025035 A) in view of Murayama et al. (U.S. Patent No. 5,972,515) and Kato (U.S. Patent No. 6,114,057), and as evidenced by Applicants' admissions and Hashimoto et al. (U.S. Patent No. 5,458,979) for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on November 27, 2007. See provided English language translation of JP '035 A.

Response to Arguments

3. **The rejection of claims 1 and 11 - 20 under 35 U.S.C § 103(a) – Kato et al. in view of various references**

Applicant(s) argue(s) that “the Examiner has yet to explain where ... “a second one of the polyurethane resins being a polyurethane resin having a urethane group concentration of 3.0 mmol/g or above” (emphasis added)” (*page 6 of response*). The Examiner respectfully disagrees.

First, the Examiner notes that the rejection of record clearly addresses this limitation on page 3 of the Office Action mailed on November 27, 2007 (“...a second one of the polyurethane resins being a polyurethane resin having a urethane concentration of 3.0 mmol/g or above (*Paragraphs 0021, 0022, 0027 and 0028*)”). Turning to Paragraphs 0021, 0022, 0027 and 0028 of Kato et al. (English language translation), especially Paragraph 0027, Kato et al. recites: “The polyurethane resin, which is used as a binder in the magnetic layer, ... with a concentration of urethane group in the polyurethane resin at 3 mmol/g or higher”.

Applicants further argue that “the Examiner has yet to explain where ... “said aromatic polyester polyurethane resin has an OH value of 10 to 500 KOH mg/g” (emphasis added)” (*page 6 of response*). The Examiner respectfully disagrees.

First, the Examiner again turns to page 3 of the above noted office action, where it is explicitly stated that Murayama et al. “teach a binder comprising a first aromatic polyester polyurethane resin ... used in combination with a second polyurethane resin”, as well as the requisite motivation for choosing to use this combination of resins over a polyurethane and vinyl based resin (*top of page 4 of prior noted Office action*). The Examiner then clearly admits on the record that “[n]one of the above disclose the specifics of the aromatic polyester polyurethane” (*second to last Paragraph of Page 4 of prior noted Office Action*). The Examiner then relies upon Kato (‘057) for “an aromatic polyester polyurethane resin ... meeting Applicants’ claimed KOH limitations (*col. 4, lines 8 – 23*) ...” (*Page 4 of prior noted Office Action*). Turning to col. 4, lines 8 – 23 of

Kato ('057), we note that Kato ('057) states "the hydroxyl value of a polyester is preferably 10 to 500 KOH mg/g, more preferably 50 to 300 KOH mg/g".

Regarding Applicants' allegations of unexpected results/"critical limitations" (pages 7 – 8 of response), Applicant(s) are reminded that ***a detailed description of the reasons and evidence*** supporting a position of unexpected results must be provided ***by applicant(s)***. A mere pointing to data requiring the examiner to ferret out evidence of unexpected results ***is not sufficient*** to prove that the results would be truly unexpected to one of ordinary skill in the art. *In re D'Ancicco*, 439 F.2d 1244, 1248, 169 USPQ 303, 306 (1971) and *In re Merck & Co*, 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986). In addition, the Examiner deems that the alleged *unexpected* results appear to be taught in the prior art, rendering the results *expected*, not *unexpected*.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The Examiner can normally be reached on M-F, 8:30 AM - 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin M. Bernatz, PhD/
Primary Examiner, Art Unit 1794

August 27, 2008